

UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 00-1312-L)

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| In re application of: |) | | |
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| Michael S. Kopreski |) | | |
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| Serial No. 10/684,633 |) | Examiner: | Lu, Frank Wei Min |
| |) | | |
| Filed: October 14, 2003 |) | Group Art Unit: | 1634 |
| |) | | |
| Title: Method Enabling Use of Extracellular |) | Confirmation No.: | 5239 |
| RNA Extracted From Plasma or |) | | |
| Serum to Detect, Monitor or Evaluate |) | | |
| Cancer |) | | |

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant submits herewith a request for reconsideration of a determination made in association with the Notice of Allowability in this application, mailed December 1, 2009. Specifically, page 2 of that paper set forth the following:

1. Note that, since applicant has not filed some references in the information disclosure statement filed on April 1, 2009, these references in the 1449 form filed on April 1, 2009 cannot be considered and have been struck through. . . .

In response, on March 1, 2010 Applicant filed a request for the Office to reconsider its refusal to consider these references, based on evidence that the references were *in fact* timely filed with the Office. This evidence consisted of Patent and Trademark Office records (from the PAIR system) which showed that the references had been submitted on April 1, 2009. In addition, Applicant submitted declaration evidence in the form of an affidavit of Dr. Nathaniel P. Chongsiriwatana, Reg. No. 65,676, a patent agent employed by Applicant's representative. In his

affidavit, Dr. Chongsiriwatana attested that he accessed the Patent Application Information Retrieval records of this application. He attested that for each of the references stricken through in the copy of the Form 1449 mailed with the Notice of Allowability, the reference was present in the PAIR system. These references include DURIE et al. (2000) (§ 5 of the Affidavit); LEE et al. (1996) (§ 6 of the Affidavit); RICCHIUTI et al. (1997) (§ 7 of the Affidavit); RICCHIUTI et al. (1999A) (§ 8 of the Affidavit); RICCHIUTI et al. (1999B) (§ 9 of the Affidavit); and SPIEGELMAN et al. (1969) (§ 10 of the Affidavit).

Based on this evidence, Applicant thus respectfully contends that the references stricken through in the Form 1449 form mailed with the Notice of Allowability should have been considered by the Office, since they were timely submitted on April 1, 2009 with the remainder of the references that *were* considered. In addition, at no time prior to mailing the Notice of Allowability did the Office make Applicant aware that it considered the references to be absent (despite the clear evidence that they were properly uploaded and present on the PAIR system). The Office had at least one previous opportunity, with Applicant's filing of a Request for Continued Examination on September 9, 2009, to inform Applicant that it considered the references to be absent (despite the clear evidence that they were properly uploaded and present on the PAIR system).

In response to Applicant's request, the Office mailed to Applicant's representative PTO Form M327B, refusing to consider the references because they failed to comply with the provisions of 37 C.F.R. § 1.97(d) and 1.97(e). Applicant respectfully contends that this refusal was improper. These provisions of the Rules are directed to references *first* submitted to the Office after Final Rejection or Notice of Allowance. The references the Office failed to consider in this application were timely submitted *according to the Office's own records* and thus are outside the scope of these provisions in the Rules. Applicant further respectfully contends that there is little more he could do to comply with Office rules than to submit the references and verify that they have been properly uploaded onto the PAIR system. It is not unreasonable to expect that such references will be considered.

Accordingly, Applicant respectfully requests that these references be considered and that consideration be duly reflected in an initialed copy of the previously-submitted Form 1449.

Applicant does not believe there are any fees to be paid for consideration of this Request. However, should the Office determine that fees are due and owing, the undersigned representative authorizes the Office to charge Deposit Account 13-2490 for the full amount of such fees.

If Examiner Lu believes it to be helpful, he is invited to contact the undersigned representative by telephone at (312) 913-0001.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Dated: April 14, 2010

By: /Kevin E. Noonan/
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Reg. No. 35,303